

REMARKS

Entry of the foregoing, re-examination and reconsideration of the subject matter identified in caption, as amended, pursuant to and consistent with 37 C.F.R. §1.112, and in light of the remarks which follow, are respectfully requested.

Claims 1-3, 7 and 8 have been canceled without prejudice or disclaimer.

Claims 4-6 have been amended at least partly in response to issues raised in the Office Action. Claims 4-6 are currently pending in this application.

Claims 1 and 4 were rejected under 35 U.S.C. §112, second paragraph, for the reason given in paragraph (2) of the Office Action. In response thereto, claim 1 has been canceled and claim 4 revised in accordance with the Examiner's suggestion. Accordingly, this rejection has been obviated and should be withdrawn.

Claims 1 and 4 were rejected under 35 U.S.C. §102(b) as anticipated by U.S. Patent No. 5,578,674 to Speth et al for the reasons set forth in paragraph (4) of the Office Action. Reconsideration and withdrawal of this rejection are respectfully requested for the following reasons.

Claim 1 has been canceled. Claim 4, as amended, is now directed to a composition comprising a component (a'), a component (b') and a component (c) as defined in the claim. Since Speth et al '674 does not disclose a composition as described in amended claim 4, the §102(b) rejection based on this reference should be withdrawn.

Claims 1, 2, 4 and 5 were rejected under 35 U.S.C. §102(b) as anticipated by U.S. Patent No. 3,988,275 to Satake et al for the reason provided in paragraph (5) of the Office

Action. Reconsideration of this rejection is respectfully requested for at least the following reasons.

Claims 1 and 2 have been canceled. Claim 4 has been amended and is directed to compositions comprising components (a'), (b') and (c) as defined therein. Claim 5, as amended, is directed to compositions comprising components (a') and (b') as defined therein. Satake et al '275 does not disclose a composition as described in amended claims 4 and 5. Accordingly, the §102(b) rejection over this reference should be withdrawn.

Claims 1-3 and 7 were rejected under 35 U.S.C. §102(b) as anticipated by U.S. Patent No. 4,554,083 to Soldanski et al for reasons set forth in paragraph (6) of the Office Action. Reconsideration of this rejection is respectfully requested for at least the following reasons.

Claims 1-3 and 7 have been canceled. Soldanski et al '083 does not disclose compositions as defined in amended claim 4-6. Accordingly, the rejection over this reference should be withdrawn.

Claims 1 and 3 were rejected under 35 U.S.C. §102(b) as anticipated by U.S. Patent No. 5,948,860 to Hiraoka et al for reasons given in paragraph (7) of the Office Action. Reconsideration and withdrawal of this rejection are respectfully requested for at least the following reasons.

Claims 1 and 3 have been canceled. Hiraoka et al '860 does not disclose compositions which include the components and proportions set forth in claims 4-6. Accordingly, this rejection should be withdrawn.

Claims 1-3 and 7 stand rejected under 35 U.S.C. §102(b) as anticipated by U.S. Patent No. 4,174,335 to Ohdaira et al for the reasons expressed in paragraph (8) of the Office Action. Reconsideration is requested of this rejection for at least the reasons which follow.

Claims 1-3 and 7 have been canceled. The compositions disclosed in Ohdaira et '335 do not include a styrene/conjugated diene block copolymer and do not anticipate the invention claimed in amended claims 4-6. Accordingly, it is requested that the §102(b) rejection based on this reference be withdrawn.

Claims 1-3 and 7 were rejected under 35 U.S.C. §102(b) as anticipated by U.S. Patent No. 6,448,321 to Tokita for reasons set forth in paragraph (9) of the Office Action. Reconsideration and withdrawal of this rejection are requested for at least the following reasons.

Initially, Applicants note that the issue date of this patent is September 10, 2002, which is subsequent to the effective international filing date of the present application, i.e., July 27, 2001. Accordingly, the '321 patent is not a proper reference under §102(b).

Moreover, claims 1-3 and 7 have been canceled. This renders moot any potential §102 rejection based on Tokita '321.

Claims 4-6 and 8 were rejected under 35 U.S.C. §103(a) as unpatentable over Tokita '321 for the reasons set forth in paragraph (12) of the Office Action. Reconsideration of this rejection is respectfully requested for at least the reasons which follow.

U.S. Patent No. 6,448,321 issued September 10, 2002, and is based on a U.S. application filed July 14, 1999. The present application is entitled to an international filing date of July 31, 2000. Accordingly, the '321 patent can only qualify as anticipatory prior art under 35 U.S.C. §102(e), i.e., "a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent."

Subject matter which is prior art under 35 U.S.C. §103(a) via 35 U.S.C. §102(e) can be disqualified as prior art if the subject matter and the claimed invention were, at the time the invention was made, owned by or subject to an obligation of assignment to the same person (35 U.S.C. §103(c); M.P.E.P. §706.02(l)(1)). The '321 patent is assigned on its face to Mitsui Chemicals, Inc. The present application is assigned to Mitsui Chemicals, Inc. by virtue of an assignment recorded on March 26, 2002, on Reel 012940, Frame 0372.

The invention claimed in the present application and U.S. Patent No. 6,448,321 were, at the time the present invention was made, owned by or subject to an obligation of assignment to Mitsui Chemicals, Inc. Therefore, the '321 patent is disqualified as prior art under 35 U.S.C. §103(a).

For at least the above reasons, the §103(a) rejection should be withdrawn.

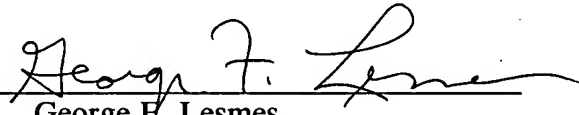
From the foregoing, further and favorable action in the form of a Notice of Allowance is believed to be next in order and such action is earnestly solicited. If there are any questions concerning this paper or the application in general, the Examiner is invited to telephone the undersigned at (703) 838-6683 at his earliest convenience.

Respectfully submitted,

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By: _____



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